

## REMARKS

In the Office Action, claims 1-24 were pending. Claims 1-24 were rejected. The Examiner made the rejections Final.

Before addressing the merits of the rejections, the Applicant requests that the Examiner reconsider the appropriateness of making the rejections Final at the present time. As stated in the MPEP §706.07, a clear issue should be developed between the examiner and applicant before final rejection is in order.

In this case, an Office Action was mailed on May 15, 2002. In the Office Action, the Examiner rejected the independent claims over US Patent Number 5,075,370 ("Kubitz"). The next Office Action, a Final Action, was mailed on October 30, 2002. The Final Action rejected the independent claims over US Patent Number 5,654,360 ("Palasz").

The Examiner relied on two different references- Palasz now and Kubitz previously in successive Office Actions to reject the claims. As stated in the MPEP §706.07, "switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter will tend to defeat attaining the goal of reaching a clearly defined issue for a final rejection." Because the Examiner relied on two different references in successive Office Actions to reject the claims, a clearly defined issue has not been reached in this case at the present time. Therefore, the Applicant request that the Final Action be withdrawn.

In regard to the merits of the rejections, the Applicant believes the current rejections should be withdrawn in light of the amendments and remarks contained in this response. The individual rejections are discussed below:

### **I. Rejection of Claims 16-19 and 21-24 under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, the Examiner states that independent claims 1 and 20 contain no crosslinkers. However, in dependent claims 16-19 and 21-24, which depend from independent claims 1 and 20, Applicant claims various crosslinkers.

Applicant has amended the claims so that crosslinkers are no longer present in the dependent claims. Therefore, the rejection of claims 16-19 and 21-24 under 35 U.S.C. 112, Second Paragraph should be withdrawn. See the claim amendments above.

## **II. Rejection of Claims 1-2, 5, 8-14, and 20 under 35 U.S.C. §102**

In the Office Action, the Examiner rejected claims 1-2, 5, 8-14, and 20 under 35 U.S.C. §102 as being anticipated by Palasz.

### **A. The Present Invention**

The present invention is a pigmented solventborne paint pack. As defined in claim 1, the invention is a pigmented solventborne paint pack which can be made into a waterborne coating composition comprising:

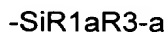
- i) a solution in an organic solvent of polymer having functional groups and hydrophilic groups; and
- ii) a waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant, the aqueous pigment dispersion itself being in dispersion in said solution of organic solvent.

The pigmented solventborne paint pack of the present invention is prepared in the following manner. First, pigment is dispersed in water in the presence of a pigment dispersant. Second, the pigment dispersed in water is dispersed into a solution of organic solvent. The solution of organic solvent is a component of the solventborne paint pack.

### **B. The Palasz Reference**

Palasz describes a water-based coating composition in two-pack form. As defined in claim 1, the invention is a water-based coating composition in two pack form adapted to be mixed together to form a crosslinking coating composition, comprising:

- i) a first pack of a nonaqueous solution, containing a water-miscible organic solvent with less than 5% by weight of water, of a silicon-containing polymer having water-solubilizing groups and selected from the group consisting of acrylic, vinyl other than acrylic, epoxy, polyurethane, polyester, and mixtures thereof which provides a solution polymer, the solution polymer being soluble in aqueous media, the silicon groups on the solution polymer being of the formula:



in which a is 0 to 2, R<sub>1</sub> is C<sub>1</sub>-6 alkyl and R is OH or a hydrolysable group, and

- ii) a second pack of a dispersion polymer selected from the group consisting of acrylic, vinyl other than acrylic, epoxy, polyurethane, polyester, and mixtures thereof in dispersion in an aqueous liquid carrier for the dispersion polymer and the coating composition,

where the first pack and second pack are adapted to be mixed together in use to form a crosslinking aqueous coating composition of the solution polymer and the dispersion polymer, where the non-volatile binder solids content of the coating composition is at least 5% by weight and the molar concentration of silicon in the composition is greater than 0 and less than 5.

As stated at column 7, line 39, the composition can comprise other conventional components such as pigments. Pigments (e.g. titanium dioxide) were introduced into the coating composition by first forming a mill base and then blending the mill base with the other constituents used in the coating composition. See col. 9, line 63. The mill base is formed by dispersing pigments in a dispersant polymer by conventional techniques.

### **C. Traversal of the Rejection**

To anticipate a claim, a single source must contain all of the elements of the claim. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

In this case, the pigment is dispersed in water in the presence of a pigment dispersant, and the aqueous pigment dispersion is itself dispersed in a polymer having functional groups and hydrophilic groups.

In contrast to the present invention, Palasz teaches preparing a pigmented coating composition in the following manner. First, pigment is dispersed using a suitable pigment dispersant polymer by conventional techniques. Second, the dispersed pigment or mill base is blended with other constituents used in the coating composition.

Palasz does not teach or suggest forming a pigmented solventborne paint pack using the dispersion technique claimed in the present invention. Palasz does not teach or suggest dispersing pigments in water in the presence of a pigment dispersant and then dispersing the dispersed pigment into a solution of polymer having functional groups and hydrophilic groups in an organic solvent. Therefore, the rejection of claims 1-2, 5, 8-14, and 20 under 35 U.S.C. §102 should be withdrawn.

### **III. Rejection of Claims 3-4 under 35 U.S.C. §103**

In the Office Action, claims 3-4 were rejected over Palasz in view of US Patent Number 5,391,630 ("Miwa").

**A. The Miwa Reference**

The Miwa reference has been cited for its disclosure of polymers having hydroxyl values of 5-500 and 50-250.

**B. Traversal of the Rejection**

Because claims 3-4 depend on an independent claim which should be allowable in light of the amendments and remarks contained in this response, the rejection of claims 3-4 under 35 U.S.C. §103 should be withdrawn.

**IV. The Rejection of Claims 6-7 and 15 under 35 U.S.C. §103**

In the Office Action, claims 6-7 and 15 were rejected over Palasz.

**A. Traversal of the Rejection**

Because claims 6-7 and 15 depend on an independent claim which should be allowable in light of the amendments and remarks contained in this response, the rejection of claims 6-7 and 15 under 35 U.S.C. §103 should be withdrawn.

**CONCLUSION**

In light of the amended claims above, the Applicant believe this application is now in condition for allowance. The Applicant respectfully request withdrawal of the following rejections: (1) the rejection of claims 16-19 and 21-24 under 35 U.S.C. § 112, Second Paragraph; (2) the rejection of Claims 1-2, 5, 8-14, and 20 under 35 U.S.C. §102 as being anticipated by Palasz; (3) the rejection of Claims 3-4 under 35 U.S.C. §103 over Palasz in view of Miwa; and (4) the rejection of claims 6-7 and 15 under 35 U.S.C. §103 over Palasz. Thank you.

Respectfully submitted,

Date: November 27, 2002

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## Appendix

### MARKED-UP VERSION OF AMENDED CLAIMS

19. (Amended) A waterborne coating composition which comprises a dispersion in an aqueous medium of the solventborne activated paint pack as claimed in claim [16] 1.

22. (Amended) A process for producing an aqueous coating composition as claimed in claim [21] 20 used to produce an aqueous coating composition further comprising the step of emulsifying the solventborne activated paint pack in an aqueous medium.

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DEC 03 2002  
**TC 1700**